

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHARON R. GARBER, CRAIG E. COLTON,
LARRY L. JANSSEN

Appeal No. 1998-2815
Application 08/648,790

HEARD: February 15, 2000

Before STONER, Chief Administrative Patent Judge, and
McCandlish, Senior Administrative Patent Judge, and FRANKFORT,
Administrative Patent Judge.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection of claims 1-48, all of the claims pending in this

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application.

Appellants' invention relates to (1) a method of selecting a respirator including the step of executing program code to determine a health effect for both a first and a second chemical and then executing program code to select a respirator based upon the health effects of the first and second chemicals and

(2) a computer readable medium including program code stored thereon including at least a database containing data on chemicals and respirators, and a non-standards based engine which when executed, performs the steps of (a) accepting first and second chemicals entered by a user and (b) selecting a respirator based upon the database and the first and second chemicals which were entered by the user. Representative claims 1 and 48 are set forth below.

1. A method of selecting a respirator comprising the steps, performed by a data processing system, of:

a) executing program code in the data processing system in order to determine a health effect of a first chemical;

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b) executing program code in the data processing system in order to determine a health effect of a second chemical; and,

c) executing program code in the data processing system in order to select a respirator based upon the health effects of the first and second chemicals.

48. A computer readable storage medium having program code stored thereon, wherein the program code includes a database containing data on chemicals and respirators, and wherein the program code further includes a non-standards based engine which, when executed, performs the steps of (a) accepting first and second chemicals which are entered by a user, and (b) selecting a respirator based upon the database and the first and second chemicals which are entered by the user.

The prior art references of record relied upon by the examiner as evidence of obviousness are:

Grilk	4,860,223	Aug. 22, 1989
Hayward et al. (Hayward)	5,574,828	Nov. 12, 1996
		(filed Apr. 28, 1994)

Claims 1-48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hayward in view of Grilk.

Rather than attempt to reiterate the examiner's full

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commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the final rejection (Paper No. 5, mailed April 18, 1997) and the examiner's answer (Paper No. 9, mailed October 21, 1997) for the reasoning in support of the rejection, and to appellants' brief (Paper No. 8, filed September 2, 1997) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness (see In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443,

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1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). The conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With this as our background, we look to the examiner's rejection of claims 1-48 under 35 U.S.C. § 103 as being unpatentable over Hayward in view of Grilk.

We understand Hayward to teach a software program system designed to write other software application programs for implementation of guideline applications for use in situations where a qualification decision or next course of action

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determination must be made. The first program is a complex expert system that includes databases and libraries for use by an expert to create a simpler program to be used by a non-expert, the simpler program asks specific questions of the non-expert and displays a decision or suggested questions to ask an expert. Hayward provides an example of use in a medical field to help a patient determine a course of action and/or suggested questions to ask the doctor, see Figures 14-28. We find nothing in Hayward that makes reference to a respirator or a method of selecting a respirator on the basis of a first and second chemical.

With respect to Grilk, we understand Grilk to teach a Carbon Monoxide (CO) monitor that includes a sensor for determining the concentration of carbon monoxide present, an LED for displaying the concentration and a microprocessor for calculating the health hazard to a person occasioned by the level of carbon monoxhemoglobin in the blood of that person resulting from breathing the known/determined concentrations of CO over a period of time. Like Hayward, Grilk makes no reference to a respirator or a method of selecting a

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respirator on the basis of first and second chemicals.

Based on the combined teachings of Hayward and Grilk and well known manuals that list harmful gases/chemicals and corresponding respirators,¹ the examiner concluded that it would have been obvious to one skilled in the art to utilize the expert system of Hayward in order to perform the same task that is presently being completed using the cumbersome manuals. The examiner further concluded that it would have been obvious to utilize computer means and databases to store information regarding health hazards due to harmful gases/chemicals.

Implicit in this rejection is the examiner's view that the

¹ The examiner's use of evidence not set forth in the statement of the rejection is improper. For purposes of this appeal, we understand that the well known manuals and databases mentioned on pages 1 and 2 of appellants' specification are relied upon by the examiner as part of the rejection of claims 1-48 under 35 U.S.C. § 103. Under such a circumstance, the well known manuals/databases clearly should have been set forth in the statement of the rejection.

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above noted modifications of Hayward would result in a method and computer readable medium with program code which corresponds to the claimed subject matter in claims 1-48 on appeal.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this case, we are in agreement with appellants that the combined teachings of Hayward and Grilk simply fail to disclose or suggest any aspect of respirator selection based on a first and second chemical, or first and second health effects thereof. The claims on appeal require at least a method step or a program code for inputting a first and a second chemical (i.e., claims 1-13 and 20-48) or a first chemical and a first exposure amount (claims 14-19) and selecting a respirator based on the first and second chemicals, the health effects of the first and second chemicals, or a first chemical and a first exposure amount. Given the total lack of any teaching in Hayward and

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Grilk regarding selection of a respirator, we must conclude that the examiner has relied upon impermissible hindsight to come to the conclusion that one of ordinary skill in the art would have combined the teachings of Hayward and Grilk so as to use the expert program of Hayward to arrive at a method and program code on a computer readable storage medium specifically designed to select a respirator based on a first and a second chemical, health effects of said first and second chemicals, or a first chemical and a first exposure amount as set forth in appellants' claims 1-48 on appeal.

With respect to the well known manuals that list harmful gases or chemicals and corresponding respirators referenced by the examiner in the Examiner's Answer, page 4, last paragraph, appellants have indicated (Brief, pp 17-21) that the known manuals for selecting respirators only provide information about one chemical at a time and not for selecting a respirator based on first and second chemicals together. Further, as argued by appellants (Brief, pp 17-21) the known manuals apparently do not consider the health effects of individual chemicals and do not consider the exposure level of

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the individual chemicals, but only provide an indication of the lowest level of exposure to a single chemical substance which requires a respirator.

In light of the foregoing, we will not sustain the examiner's rejection of claims 1-48 under 35 U.S.C. § 103 as being unpatentable over Hayward in view of Grilk.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-48 under 35 U.S.C. § 103 is reversed.

REVERSED

BRUCE H. STONER, JR
Chief Administrative Patent Judge

HARRISON E. MCCANDLISH
Senior Administrative Patent Judge

INTERFERENCES

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CHARLES E. FRANKFORT)
Administrative Patent Judge)

CEF:lmb

TREVOR B. JOIKE
MARSHALL, O'TOOLE, GERSTEIN, MURRAY & BORUN
6300 SEARS TOWER
233 SOUTH WACKER DRIVE
CHICAGO, IL 60606-6402